

REMARKS

Claim 37 has been amended and new claims 39 and 40 have been added. Claims 1-3, 5, 6 and 8-40 are pending in the application. Entry of the amendments contained herein and reconsideration of the application are requested in view of the amendments and the remarks to follow.

The amendments to the specification correct minor informalities noted during review, bring the drawings and specification into mutual conformance and/or are responsive to concerns expressed in the Office Action. No new matter is added by these amendments to the specification.

The amendments to claim 37 are responsive to the concerns noted in the Office Action (p. 2, item 1) and/or address minor informalities noted during review. No new matter is added by these amendments, and the amendments directed to address minor informalities are not intended to alter the scope of the claims.

The amendments to the specification and claims, and new claims 39 and 40, are supported at least by page 3, line 22 through page 12, line 20 of the specification, and the drawings, as filed. No new matter is added by these amendments or new claims. New claims 39 and 40 distinguish over the art of record and are allowable.

Traverse of Rejections under 35 U.S.C. §112

Claims 37 and 38 stand rejected under 35 U.S.C. §112, 2ND ¶, as being indefinite. The specification has been amended responsive to the concerns noted in the Office Action. Additionally, a copy of page 470 of Merriam Webster's Collegiate Dictionary, Tenth Edition (Merriam-Webster, Springfield MA, copyright 1993) is enclosed to assist in interpretation of the language employed in describing the drawings. Accordingly, the rejection under 35 U.S.C. §112 is moot.

Traverse of Rejections under 35 U.S.C. §102

Claims 1-3, 5, 6, 12-18, 27, 28 and 32-34 stand rejected under 35 U.S.C. §102(e) as being anticipated by Wefers et al. (hereinafter "Wefers"), U.S. Patent No. 6,458,211. Claims 11, 22, 25 and 26 stand rejected under 35 U.S.C. §102(b) as being anticipated by Matsunaga (hereinafter "Matsunaga"), U.S. Patent No. 5,389,148. Applicant disagrees and requests reconsideration in view of the remarks to follow.

Anticipation is a legal term of art. Applicant notes that in order to provide a valid finding of anticipation, several conditions must be met: (i) the reference must include every element of the claim within the four corners of the reference (see MPEP §2121); (ii) the elements must be set forth as they are recited in the claim (see MPEP §2131); (iii) the teachings of the reference cannot be modified (see MPEP §706.02, stating that "No question of obviousness is present" in conjunction with anticipation); and (iv) the reference must enable the invention as recited in the claim (see MPEP §2121.01). Additionally, (v) these conditions must be simultaneously satisfied.

The §102 rejection of claims 1-3, 5, 6, 11-18, 22, 25-28 and 32-34 is believed to be in error. Specifically, the PTO and Federal Circuit provide that §102 anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). The corollary of this rule is that the absence from a cited §102 reference of any claimed element negates the anticipation. Kloster Speedsteel AB, et al. v. Crucible, Inc., et al., 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

Applicant also notes the requirements of MPEP §2131, which states that **"TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY**

ELEMENT OF THE CLAIM." This MPEP section further states that "'A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)."

To clarify the nature of anticipation, Applicant notes the following language set forth in 35 U.S.C. §103(a):

A patent may not be obtained though the invention is not **identically disclosed or described** as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This language sets forth Congressional intent in clear and exact terms as to what does or does not comprise anticipation, as compared to unpatentability. The reference must contain, within its four corners, **exactly** the subject matter of the claim, as it appears in the claim, in order to support a valid finding of anticipation.

Wefers is directed (Title) to a "device and method for applying a medium to a substrate, system having a plurality of such devices, and use of such device, method and system". More specifically, Wefers teaches (Abstract) that:

The invention relates to a device and to a method for applying a medium in the form of liquid, powder or paste to a substrate, having a container for the medium and a transport device which takes the medium from the container and discretely distributes it. In a propelling device the medium is selectively transferred from the transport device to the substrate with a propellant which is separate from the medium, or in the propelling device the medium is selectively removed from the transport device, and the remaining medium is transferred from the transport device to the substrate.

In contrast to Wefers, claim 1 recites "A device for printing onto a medium, said device comprising: a mesh-like substrate having multiple holes; each of said holes being configured to hold a material for application onto said medium, wherein said material is a solid; a nozzle to expel a fluid to cause said material to be applied onto said medium if said fluid is expelled onto said material by said nozzle, wherein at least one of said nozzle and said substrate is maneuverable such that said nozzle may be disposed substantially directly over at least one of said holes at a time; and wherein said nozzle is operable to expel said fluid onto said material to thereby cause said material to be applied onto said medium and thereby print an image on said medium", which is not taught or disclosed by Wefers.

Dependent claim 5 recites that the device of claim 1 further comprises "a scraper for removing excess material from said mesh-like substrate". A scraper is an instrument suitable for removing a paste, a powder, a solid or a liquid.

The Office Action states (p. 11, item 13) that "with respect to the conflict between the terms 'scraper' and 'squeegee', applicant argues that a scraper is an instrument suitable for removing a paste, a powder, a solid or a liquid. Wefers et al. teaches "a device and a method for applying a medium in liquid, powder or paste form to a substrate", see column 3, lines 56-58, and squeegees, 7, "set such that excess medium is taken off the transport device 1 and falls back into the container 8". Therefore, while Wefers et al. uses the

term 'squeegee' rather than applicant's term scraper, the device performs the same function as the scraper claimed by applicant and therefore satisfies the teaching of the claimed limitation."

However, this is not the test for a valid finding of anticipation, and appears to result from misapplication of the doctrine of equivalents used in a finding of non-literal infringement. In that context, a backdrop of comparison has already been established, and it has already been determined that the claims do not anticipate. The substantial equivalence test is not appropriate for an attempt to establish anticipation but does function as an admission, on the record, that Wefers does not anticipate the claimed subject matter.

In further contrast to the teachings of Wefers, claim 12 recites "A method for printing onto a medium, said method comprising: applying a material onto a mesh-like substrate having a hole, wherein said material is a solid; filling a portion of said hole with said material; and expelling a fluid from a nozzle at a substantially high rate of speed toward said material held within said hole, wherein said fluid is configured to contact said material and cause said material to be substantially forced out of said hole and applied onto said medium", which is not taught or disclosed by Wefers.

Dependent claim 13 recites that the method according to claim 12 further comprises "removing excess material from said hole with a scraper".

As previously noted (Response dated Jan. 14, 2004 at page 23 et seq.), Wefers explicitly teaches use of a squeegee, using this term no less than 19 separate times in Wefers' disclosure. Wefers *explicitly* identifies element(s) 7, 7' of Figs. 1-3 and element 57 of Figs. 11 and 12 as a "squeegee" or "roller squeegee" in more than 15 separate instances in the disclosure, *and provides no alternative examples of devices for this function*. A roller squeegee is not a

'scraper'. Applicant notes with particularity that the Examiner has not responded to this repeated legal argument. It is not possible to clear a windshield of frost using a 'roller squeegee', rather than a 'scraper', for example.

While some squeegees may fall within the ambit of the term "scraper", the converse is not true. In other words, all blade squeegees are forms of scrapers, but many scrapers are not squeegees; as noted above, a squeegee is not suited to removal of a solid applied to a mesh-like substrate, as recited in claims 1 and 12.

In particular, a scraper (as recited in claim 5) suited for removal of: a solid applied to a mesh-like substrate (as recited in claim 1) is not a squeegee, and to equate the squeegee taught by Wefers for the subject matter recited in Applicant's claims improperly gives the term "squeegee" a meaning repugnant to the ordinary meaning of the term (see MPEP §2111.01, entitled "Plain Meaning"). The interpretation of Applicant's claim 1 relied on by the Examiner clearly gives the term "squeegee", as used in Wefers, a meaning repugnant to the ordinary meaning of the term. Similarly, removing excess material with a scraper (as recited in claim 13) suited for removal of a solid applied to hole in a mesh-like like substrate (as recited in claim 12), is not equivalent to use of a squeegee for removal of a liquid, as taught by Wefers.

Definitions of the terms "squeegee" and "scrape" taken from Merriam-Webster's Seventh Collegiate Dictionary (G. & C. Merriam Co., Springfield, Massachusetts, copyright 1971) have been previously provided with the Response dated January 14, 2004. The Examiner has **again** failed to rebut the legal arguments provided by Applicant.

Additionally, because a squeegee is not suited to removal of a solid, where the solid is applied to holes in a mesh, as recited in claims 1 and 12, the

teachings of Wefers do not provide an enabling disclosure of the subject matter of claims 1 and 12 and claims dependent therefrom. Application of 35 U.S.C. §102 with respect to the legal concept of anticipation requires that the reference enable the subject matter claimed (see MPEP §2121.01, referenced hereinabove). Mere mention in passing of an exemplary powder (as in Wefers - see Abstract; Field of the Invention & Summary) without any description of appropriate hardware to support use of such, does not provide a disclosure of such that is enabling in the sense of 35 U.S.C. §112 or as is necessary for a proper finding of anticipation (see item (iv), supra). In fact, the Description of Preferred Embodiments of Wefers is void of any mention whatsoever of any powder and the entirety of Wefers is void of the term "solid".

Further, because Wefers fails to set forth an enabling description of the subject matter of claims 1 and 12, the teachings of Wefers must be impermissibly modified to attempt to arrive at the subject matter of these claims (see item (iii), supra, and MPEP §706.02). Additionally, because Wefers fails to set forth the elements as they are recited in the claims (see item (ii), supra, and MPEP §2131), the anticipation rejection fails another element needed in order to provide a valid finding of anticipation. Moreover, because Wefers does not teach or describe the subject matter of claims 5 and 13, with respect to at least these claims, the anticipation rejection also fails to include every element of the claim within the four corners of the reference, as is required for a valid finding of anticipation (see item (i), supra, and MPEP §2121).

Claim 27 recites "A device for printing onto a medium comprising: a mesh-like substrate having multiple holes therethrough; each of the holes being configured to hold a material for application onto the medium; a scraper for

removing excess material from the mesh-like substrate; a nozzle to expel a fluid to cause the material to be applied onto the medium when the fluid is expelled onto the material by the nozzle, wherein at least one of the nozzle and the substrate is maneuverable such that the nozzle may be disposed substantially directly over at least one of the holes at a time such that the material does not make contact with the nozzle; and wherein the nozzle is operable to expel the fluid onto the material to thereby cause the material to be applied onto the medium and thereby print an image on the medium", which is not taught or disclosed by Wefers.

The Office Action (page 4) references different portions of Wefers in an effort to find anticipation with respect to the subject matter recited in claim 27. More specifically, the Office Action alleges that portions of the subject matter of claim 27 are analogous to portions of Wefers at col. 8, lines 49-51 and Fig. 1, while other portions of the recited subject matter are alleged to be analogous to portions of Wefers at col. 9, lines 14-16 and Fig. 11, and yet other portions are alleged to be analogous to portions of Wefers at col. 9, lines 46-56.

The Office Action further states (page 12) that "In response to applicant's arguments that different embodiments of Wefers et al. have been used to make the rejection, there is no indication in the reference that the claimed elements of Figure 1 are not present in the embodiment of Figure 11. In fact, from the drawing [sic] all of the elements rejected using the description of Figure 1 appear to be present in the embodiment of Figure 1 as well."

Such ignores the characterization by Wefers of Fig. 11. For example, at col. 12, line 51 et seq., Wefers explicitly states that: "FIG. 11 and 12 illustrate the indirect method according to the invention." Wefers obviously considers these Figs. and accompanying text as describing an alternative, or disjunctive,

concept, with respect to the disclosure vis-a-vis Fig. 1. As such, Wefers does not even provide motivation for the modifications suggested in the Office Action.

More particularly, Wefers discloses a plurality of embodiments. Even more specifically, at col. 7, line 59 et seq., Wefers states that: "FIGS. 1 to 3 show schematic sectional representations of various illustrative embodiments of the device according to the invention, FIG. 4 shows a schematic plan view of a further illustrative embodiment of the device according to the invention, FIG. 5 shows a schematic sectional representation of a further illustrative embodiment of the device according to the invention," Thus, Figs. 1 through 5 each describe different embodiments.

The text at col. 8, lines 49-51 and at col. 9, lines 46-56 describe Fig. 1. The text at col. 9, lines 14-16 describes Fig. 11, as indeed admitted in the Office Action. Wefers states (col. 8, lines 19 and 20) that: "FIG. 11 shows a schematic perspective view of a further device according to the invention". In other words, Wefers clearly states that Fig. 11 is directed to another embodiment. "Mixing and matching" selected portions of the teachings of Wefers directed to different embodiments constitutes modification of the teachings of the reference that is impermissible in attempting to establish anticipation (see, e.g., MPEP §706.02). The nature of the arguments presented in the Office Action establishes, on the record, an admission that Wefers does not set forth the subject matter of the claim as it appears in the claim (see MPEP §2131). Because Wefers does not teach or disclose the subject matter of claim 27, Wefers cannot possibly enable such subject matter (see MPEP §2121.01).

Moreover, because the anticipation rejection fails numerous critical aspects of the criteria set forth in the MPEP and case law for a valid finding of anticipation, the rejection cannot possibly meet these aspects simultaneously (see item (v), supra). As such, the anticipation rejection of claims 1-3, 5, 6, 12-18, 27, 28 and 32-34 is defective and should be withdrawn, and claims 1-3, 5, 6, 12-18, 27, 28 and 32-34 should be allowed.

Matsunaga is directed (Title) to a "spray apparatus utilizing porous sheet". More specifically, Matsunaga teaches (Abstract):

A spray method and apparatus for uniformly coating a surface with a high degree of efficiency includes filling the pores of a porous sheet with a liquid and then directing compressed fluid from a nozzle into the sheet from one side to spray the liquid onto a surface spaced from an opposite side. Because the total volume of the pores is known, the volume of the sprayed liquid is also known. Moving the nozzle relative to the sheet and the substrate enables the entire surface to be uniformly coated. The size and distribution of the pores on the sheet define the distribution of the liquid sprayed onto the substrate. The coating may be a thick or a thin film of uniform thickness, or may even comprise a recognizable pattern.

More specifically, Matsunaga is concerned with improving uniformity of deposition of material on a substrate (see, e.g., Field of the Invention), stating (col. 1, lines 28-43) that:

It is an objective of this invention to improve the uniformity in thickness of a liquid coating applied to a surface.

It is another objective of the invention to more efficiently spray coat a surface by reducing dispersion.

The above-stated objectives are achieved by filling the pores of a porous sheet with a liquid and then pushing the liquid out of the pores by pressure to transfer the liquid onto the surface to be coated. Preferably, the liquid is pushed out of the pores by spraying a compressed fluid.

By wiping the excess liquid from the sheet prior to transfer, only a volume of liquid equal to the volume of the pores will remain. If the volume of the pores is known, the volume of the liquid transferred to the surface will be known with a high degree of accuracy.

Implicit in these objectives is that the volume of the pores must be constant from one pore to another or must vary in some known and predetermined way. Matsunaga further teaches (col. 3, lines 19-24; Fig. 1C) that both sides of the porous sheet must be wiped in order to guarantee known volumes of liquid in the pores, stating that:

FIG. 1C depicts the sheet 10 after opposing sides have been wiped, or scraped, of excess liquid 14. This wiping step leaves the liquid 14 only within the pores 12 of the sheet 10. Therefore, if the total volume of the pores 12 is known, the total volume of liquid 14 held by the sheet 10 is also known.

Applicant, in contrast, has developed a process whereby the nozzle may be chemically incompatible with the material, stating (p. 4, lines 3-5) that implicit in this is the lack of contact between the material and the nozzle. In other words, Matsunaga is directed to a different set of problems than are contemplated by Applicant, and, as such, Matsunaga cannot possibly describe the subject matter of claim 22 or enable such.

The Office Action states (page 12, item 13) that "In response to applicant's arguments with respect to claim 22, that the objectives of Matsunaga differ from those of applicant, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the device of Matsunaga meets all of the limitations claimed by applicant." The Examiner is citing from MPEP §707.07(f), entitled "Answer All Material Traversed", without attribution.

Again, this position appears to inappositely conflate legal precedent and procedure applicable in contexts where it has already been determined that anticipation does not exist, with the legal concept of anticipation. More specifically, *In re Casey* is also cited at MPEP §2115:

In *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967), an apparatus claim recited "[a] taping machine comprising a supporting structure, a brush attached to said supporting structure, said brush being formed with projecting bristles which terminate in free ends to collectively define a surface to which adhesive tape will detachably adhere, and means for providing relative motion between said brush and said supporting structure while said adhesive tape is adhered to said surface." An obviousness rejection was made over a reference to Kienzle which taught a machine for perforating sheets. The court upheld the rejection stating that "the references in claim 1 to adhesive tape handling do not expressly or impliedly require any particular structure in addition to that of Kienzle." The perforating device had the structure of the taping device as claimed, the difference was in the use of the device, and "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself."

Obviously, *In re Casey* is unrelated to anything to do with a valid finding of anticipation. Similarly, *In re Otto* concerns a finding of obviousness (see, e.g., the quotation in the first column of page 459 of 136 USPQ). Copies of the cited cases are enclosed for the Examiner's convenience. The portion of the MPEP that the Examiner is relying on is completely inapposite to anticipation. Applicant explicitly notes that the Examiner has failed completely to respond to this legal argument.

Claims 11, 25 and 26 distinguish by virtue of dependence from an allowable claim and for their own recitations which are neither taught nor disclosed by the cited reference.

For at least these reasons, the anticipation rejection of claims 11, 22, 25 and 26 is in error and should be withdrawn, and claims 11, 22, 25 and 26 should be allowed.

Rejections under 35 U.S.C. §103

Claims 8, 9, 29, 30 and 35 stand rejected under 35 U.S.C. §103 as being unpatentable over Wefers in view of Matsunaga. Claims 10 and 31 stand rejected under 35 U.S.C. §103 as being unpatentable over Wefers in view of Matsunaga and further in view of U.S. Patent No. 4,205,320 to Fujii et al. (hereinafter "Fujii"). Claims 19-21 stand rejected under 35 U.S.C. §103 as being unpatentable over Wefers in view of U.S. Patent No. 5,964,158 to Takahashi (hereinafter "Takahashi"). Claims 23, 37 and 38 stand rejected under 35 U.S.C. §103 as being unpatentable over Matsunaga in view of Fujii. Claims 24 and 36 stand rejected under 35 U.S.C. §103 as being unpatentable over Matsunaga in view of Wefers. Applicant disagrees and requests reconsideration.

Wefers, as noted above with respect to the anticipation rejections, is directed to a printer-type device suitable for printing liquid materials onto a substrate and does not describe a scraper. Matsunaga is also directed to a printer-type device, but critically relies on printing liquid materials onto a substrate. In fact, Matsunaga is void of the terms "solid" or "powder".

In contrast to the disclosure of the references, Applicant's claim 8 recites "A device for printing onto a medium, the device comprising: a mesh-like substrate having multiple holes; each of the holes being configured to hold a material for application onto the medium, wherein the material is a solid; a nozzle to expel a fluid to cause the material to be applied onto the medium when the fluid is expelled onto the material by the nozzle, wherein at least one of the nozzle and the substrate is maneuverable such that the nozzle may be disposed substantially directly over at least one of the holes at a time; and wherein the nozzle is operable to expel the fluid onto the material to thereby cause the material to be applied onto the medium and thereby print an image

on the medium, wherein said at least one hole comprises a generally conical configuration", which is not taught, disclosed, suggested or motivated by the cited references, alone or in any proper combination.

Additionally, Applicant's claim 9 recites "A device for printing onto a medium, the device comprising: a mesh-like substrate having multiple holes; each of the holes being configured to hold a material for application onto the medium, wherein the material is a solid; a nozzle to expel a fluid to cause the material to be applied onto the medium when the fluid is expelled onto the material by the nozzle, wherein at least one of the nozzle and the substrate is maneuverable such that the nozzle may be disposed substantially directly over at least one of the holes at a time; and wherein the nozzle is operable to expel the fluid onto the material to thereby cause the material to be applied onto the medium and thereby print an image on the medium, further comprising a power source connected to said mesh-like substrate to supply electricity to said mesh-like substrate, whereby said material may be held within said hole by a charged attraction between said mesh-like substrate and said material", which is not taught, disclosed, suggested or motivated by the cited references, alone or in any proper combination.

Claim 35 recites "A device for printing onto a medium comprising: a mesh-like substrate having multiple holes therethrough, wherein the substrate comprises a substantially disc-shaped configuration having a central opening, each of the holes being configured to hold a solid material for application onto the medium; a scraper for removing excess material from the mesh-like substrate; a nozzle to expel a fluid to cause the material to be applied onto the medium when the fluid is expelled onto the material by the nozzle, wherein at least one of the nozzle and the substrate is maneuverable such that the nozzle

may be disposed substantially directly over at least one of the holes at a time such that the material does not make contact with the nozzle and wherein said at least one hole comprises a generally conical configuration; and wherein the nozzle is operable to expel the fluid onto the material to thereby cause the material to be applied onto the medium and thereby print a portion of an image being formed on the medium", which is not taught, disclosed, suggested or motivated by the cited references, alone or in any proper combination.

Because Matsunaga teaches (see rejection under 35 U.S.C. §102) need to carefully control volume of material contained in each pore and thus teaches use of a liquid material, elaborate scraping and the like, attempting to combine the teachings of Wefers and Matsunaga to arrive at the subject matter of claims 8, 9 or 35, each reciting a solid material, defeats the main intent of Matsunaga. It is improper to modify the teachings of a reference in a fashion that renders the teachings of the reference unsuitable for their intended purpose, as is explained below in more detail with reference to MPEP §2143.01.

In a subsection entitled "THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE", this MPEP portion states that "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)" Because combining the teachings of Matsunaga with the teachings of Wefers to try to arrive at the subject matter of any of claims 8, 9 or 35 defeats the intended purpose taught by Matsunaga, it is improper to combine the teachings of these references in an attempt to find unpatentability.

The Office Action suggests (page 12, item 13) that "Wefers teaches a device that is suitable for use in applying a medium in liquid, powder, or paste form, with every indication that the structure described is suitable for each of these types of medium, rather than merely for liquid, as applicant suggests." The Office Action is notably void of any indication whatsoever, in any location, of any such suggestion to be found in the references. Further, the Office Action states (page 11, item 13), that Applicant's detailed rebuttal (see Office Action Response dated May 26, 2004, particularly at page 19 et seq.) amounts "to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references."

Applicant is puzzled by such allegation, particularly in light of (i) no less than twenty-plus pages of precisely such specificity (see, e.g., pages 16-38 of the Response to Office Action dated May 26, 2004), and (ii) the Examiner's repeated failure to respond to the arguments tendered by Applicant. One consequence of such failure is a lack of evidence, on the record, that the Examiner has read, understood, considered, and responded to such legal arguments. Clarification is respectfully requested.

Claim 36 recites "A device for printing onto a medium, said device comprising: a mesh-like substrate having multiple holes; each of said holes being configured to hold a material for application onto said medium, wherein said material is a liquid, wherein the density of the material is configured to prevent a substantial portion of the material from penetrating through each of the holes, and wherein the diameter of each of the holes is configured to substantially prevent the material from penetrating therethrough; a scraper configured to scrape only one side of the mesh-like substrate; a nozzle to expel

a fluid to cause said material to be applied onto said medium if said fluid is expelled onto said material by said nozzle; a power source connected to said mesh-like substrate to supply electricity to said mesh-like substrate, whereby said material may be held within said holes by a charged attraction between said mesh-like substrate and said material; wherein at least one of said nozzle and said substrate is maneuverable such that said nozzle may be disposed substantially directly over at least one of said holes at a time such that the material does not make contact with the nozzle; and wherein said nozzle is operable to expel said fluid onto said material to thereby cause said material to be applied onto said medium and thereby print an image on said medium", which is not taught, disclosed, suggested or motivated by the cited references, alone or in any proper combination.

Matsunaga states (col. 3, line 6 et seq.; see Figs. 1A through 1E) that:

FIG. 1B shows a liquid or melted substance 14 filled within the pores 12 and surrounding opposite sides of the sheet 10. The liquid 14 may be a paint or an adhesive with high or low viscosity and it may include water, oil, organic solvent, or solder, or the liquid may be a melted substance such as paraffin wax, hot melt adhesive, hot melt coating, or solder. Capillary action and/or the viscosity of the liquid 14 keeps it from flowing out of the pores 12. For the remainder of this detailed description of the drawings, and in the claims, the term "liquid" refers to any liquefied flowable substance which may be filled into the pores 12 and then transferred outwardly therefrom by pressure.

FIG. 1C depicts the sheet 10 after opposing sides have been wiped, or scraped, of excess liquid 14. This wiping step leaves the liquid 14 only within the pores 12 of the sheet 10. Therefore, if the total volume of the pores 12 is known, the total volume of liquid 14 held by the sheet 10 is also known.

Matsunaga clearly relies on a process whereby a surplus of material is applied to a carrier having pores of known volume and then excess material is removed to provide a known amount of material in each pore. This process is defeated in adapting Matsunaga to attempt to arrive at the subject matter recited

by Applicant in claim 36, wherein "the density of the material is configured to prevent a substantial portion of the material from penetrating through each of the holes, and wherein the diameter of each of the holes is configured to substantially prevent the material from penetrating therethrough". Fig. 1B of Matsunaga clearly shows material penetrating through the holes and extending away therefrom on both sides of the sheet.

As noted above, it is improper to modify the teaching of a reference in such a way as to defeat the intended purpose of the reference in attempting to establish unpatentability.

For at least these reasons, the rejection of claims 8, 9, 35 and 36 is prima facie defective and should be withdrawn, and claims 8, 9, 35 and 36 should be allowed.

Fujii is directed to (Title) a "wet type direct image recording method". More particularly, Fujii describes (Abstract): "A wet type direct image recording method an apparatus wherein an ink/image is formed directly on a surface treated recording material by passing the recording material between an image signal voltage applying electrode and an ink supplier device. The surface of the ink supplier device has depressions in its surface layer, which permit capillarity of the ink, thereby the ink is held in the surface layer of the ink supplier device, and at least either of the ink and the surface layer of the ink supplier device is electrically conductive so that the ink or the ink supplier device serves as a counter electrode for the image signal voltage applying electrode. The ink in the depressions is easily attracted electrostatically to the surface of the recording material when an electric field is formed between the image signal voltage applying electrode and the ink or the ink supplier device

since the surface tension of the ink is reduced significantly by the electric field."

In contrast, claim 10 recites "The device according to claim 9, wherein said supplied electricity is capable of magnetically charging said mesh-like substrate, wherein said material is held within said hole by a magnetically charged attraction between said substrate and said material", while claim 31 recites "The device of claim 30, wherein the supplied electricity is capable of magnetically charging the mesh-like substrate, wherein the material is held within the holes by a magnetically charged attraction between the substrate and the material", which recitations are not taught, disclosed, suggested or motivated by either or any of Wefers, Matsunaga or Fujii, alone or in any proper combination.

As noted above, combining the teachings of Wefers and Matsunaga defeats the intended purpose taught by Matsunaga and thus such combination is improper. Adding in the recitation of claim 7 of Fujii (col. 6, lines 35-42 is a portion of this claim and includes the ONLY mention of the term "magnetic" in the entirety of Fujii) fails to cure these deficiencies.

Additionally, Fujii is directed to a wet-type recording technique and apparatus wherein (col. 1, lines 6-16):

The present invention relates to a wet type direct recording method for recording an image information directly on a recording material, and more particularly to a wet type direct recording method in which an ink image is formed directly on a plain paper by passing the plain paper between an image signal voltage applying electrode and an ink bearing ink supplier which serves as a counter electrode, and the ink to which an image signal voltage is applied is attracted to the surface of the paper by the surface tension of the ink being reduced selectively.

Fujii teaches (col. 1, line 63 et seq.) that such provides benefits:

Moreover, since this recording method is a wet type recording method, a fixing process is unnecessary and an ink image is

directly formed on the recording material by applying an electric field corresponding to an image signal, an intermediate medium for image formation and processes, such as development, image transfer, and cleaning are unnecessary. As a result, the recording apparatus can be made compact and at the same time, the operation reliability of the recording apparatus can be raised significantly. Furthermore, since plain paper can be employed as the recording material for use with this recording apparatus, the recording cost can be lowered in comparison with the conventional recording process.

Fujii thus teaches away from the types of processes recited in claims 9 and 31, as well as the teachings of Wefers and/or Matsunaga. Applicant notes the requirements of MPEP §2145, in a subsection (X)(D)(2) entitled "References Cannot Be Combined Where Reference Teaches Away from Their Combination".

This MPEP subsection states that: "It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)". It is thus improper to attempt to combine the teachings of Fujii with anything to try to arrive at the subject matter of claim 9 or of claim 31. For at least these reasons, the rejection of claims 9 and 31 is improper and should be withdrawn, and claims 9 and 31 should be allowed.

Takahashi is directed to (Title) a "magnetic ink character detection apparatus and controlling method therefore [sic]". More particularly, Takahashi describes (Abstract): "An apparatus and control method therefor which compensates differences among individual media in detected signal amplitudes caused by imperfect magnetic ink character printing conditions without requiring an adjustment of amplitude of a received signal amplifier. Preferably, the magnetic ink character detection apparatus of the present invention includes a moving device that moves the magnetic head and/or the medium relative to each other at a predetermined speed; an amplitude detection

unit for detecting the amplitude and/or saturation amount of the electrical signals output from the magnetic head; and a moving-speed determination unit for determining the relative moving speed caused by the moving device in accordance with the output from the amplitude detection unit."

In contrast, claim 19 recites "A computer readable storage medium on which is embedded one or more computer programs, said one or more computer programs implementing a method for printing onto a medium, said one or more computer programs comprising a set of instructions for: applying a material onto a mesh-like substrate having a hole, wherein said material is a solid; filling a portion of said hole with said material; and expelling a fluid from a nozzle at a substantially high rate of speed toward said material held within said hole, wherein said fluid is configured to contact said material and cause said material to be substantially forced out of said hole and applied onto said medium", which is not taught, disclosed, suggested or motivated by the cited references.

As noted above, Wefers is directed to use of wet materials for printing. Takahashi is not directed to printing anything and instead addresses reading of characters previously printed using magnetically-active inks. Applicant notes that the Office Action states (p. 8) that "Takahashi teaches a computer readable storage medium on which is embedded one or more computer programs which implement a method for printing onto a medium" but provides no indication whatsoever as to where such teaching might be found in Takahashi. Inasmuch as Takahashi has nothing to do with any such teaching, it is inconceivable that combining the teachings of these two references could possibly provide the subject matter of claim 19 or claims 20 or 21.

Clarification of the rejection vis-à-vis the "teachings" of Takahashi is **yet more once again** respectfully requested.

As a result, combining the teachings of these references does not and cannot provide the subject matter of claim 19 or claims dependent therefrom. For at least these reasons, the rejection of claims 19-21 is prima facie defective and should be withdrawn, and claims 19-21 should be allowed.

Claim 23 recites "The device according to claim 22, wherein said supplied electricity is capable of magnetically charging said mesh-like substrate, wherein said material is held within said hole by a magnetically charged attraction between said substrate and said material", which recitations are not taught, disclosed, suggested or motivated by either or any of Matsunaga or Fujii, alone or in any proper combination.

Adding the recitation of claim 7 of Fujii (col. 6, lines 35-42 is a portion of this claim and includes the ONLY mention of the term "magnetic" in the entirety of Fujii) to the teachings of Matsunaga fails to cure these deficiencies.

Claim 24 recites "The device of claim 22, wherein at least one of the nozzle and the substrate is maneuverable such that the nozzle may be disposed substantially directly over at least one of the holes at a time such that the material does not make contact with the nozzle", while claim 36 recites "A device for printing onto a medium, said device comprising: a mesh-like substrate having multiple holes; each of said holes being configured to hold a material for application onto said medium, wherein said material is a liquid, wherein the density of the material is configured to prevent a substantial portion of the material from penetrating through each of the holes, and wherein the diameter of each of the holes is configured to substantially prevent the material from penetrating therethrough; a scraper configured to scrape only one

side of the mesh-like substrate; a nozzle to expel a fluid to cause said material to be applied onto said medium if said fluid is expelled onto said material by said nozzle; a power source connected to said mesh-like substrate to supply electricity to said mesh-like substrate, whereby said material may be held within said holes by a charged attraction between said mesh-like substrate and said material; wherein at least one of said nozzle and said substrate is maneuverable such that said nozzle may be disposed substantially directly over at least one of said holes at a time such that the material does not make contact with the nozzle; and wherein said nozzle is operable to expel said fluid onto said material to thereby cause said material to be applied onto said medium and thereby print an image on said medium", which subject matter is not taught, disclosed, suggested or motivated by the cited references. As noted above, attempting to combine the teachings of Matsunaga and Wefers defeats the intended purpose of Matsunaga.

Further, with respect to all of the unpatentability rejections, simply providing a conclusory statement that "It would have been obvious" fails to meet the standards set forth in the MPEP for establishing a prima facie case of unpatentability. These are set forth in MPEP §2143, entitled "Basic Requirements of a Prima Facie Case of Obviousness" (see also MPEP §706.02(j), §2141 et seq. and §2142).

This MPEP section states that "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." The references fail to teach or disclose the elements recited in the claims, as discussed with specificity, infra,

as well as in prior Responses. Accordingly, the references cannot provide motivation to modify their teachings to arrive at the invention as claimed, and the Examiner has identified no such teaching or disclosure in the references. As a result, the first prong of the test cannot be met.

MPEP §2143 further states that "Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Inasmuch as the references fail to provide all of the features recited in Applicant's claims, the third prong of the test is not met. As a result, there cannot be a reasonable expectation of success. As such, the second prong of the test cannot be met.

MPEP §2143 additionally states that "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." This fourth criterion cannot be met because the references fail to teach or disclose the elements recited in the claim. As such, the unpatentability rejections fail all of the criteria for establishing a prima facie case of obviousness, as set forth in the MPEP.

Inasmuch as there is no teaching or disclosure, or guidance, suggestion or motivation identified in the references or by the Office Action to attempt to combine or modify, or to aid one of ordinary skill in picking and choosing elements from the diverse embodiments of the references or in assembling those elements to attempt to arrive at the subject matter of any of Applicant's claims. As such, the rejection appears to employ an inappropriate 'obvious to try' standard of unpatentability.

Such is improper, as is discussed below in more detail with reference to MPEP §2145(X)(B), entitled "Obvious To Try Rationale". This MPEP section states that "The admonition that 'obvious to try' is not the standard under §103 has been directed mainly at two kinds of error. In some cases, what would have been 'obvious to try' would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful. In others, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it." *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (citations omitted)".

In this instance, no guidance in selecting some but not others of the many elements from the many embodiments of the references is identified. Similarly, no direction as to which of many possible choices is likely to be successful has been identified.

As there is no basis for the Examiner's contentions within the cited references, the only possible motivation for these contentions is hindsight reconstruction wherein the Examiner is utilizing Applicant's own disclosure to construct a reason for combining and/or modifying the teachings of the cited references. The Examiner is reminded that hindsight reconstruction is not an appropriate basis for a §103 rejection. (See, e.g., *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990) (explaining that hindsight reconstruction is an improper basis for rejection of a claim).)

Moreover, no evidence has been provided as to why it would be obvious to combine or modify the teachings of these references. Evidence of a suggestion to combine or modify may flow from the prior art references themselves, from the knowledge of one skilled in the art, or from the nature of the problem to be solved. However, this range of sources does not diminish the requirement for actual evidence. Further, the showing must be clear and particular. See *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999).

Examination Deficiencies

Additionally, the Examiner's response to argument is deficient in multiple regards. A first deficiency is that the response to argument clearly fails to fully respond to all of Applicant's arguments with respect to the rejections under 35 U.S.C. §102, or, in the alternative, is an admission that these rejections are defective.

Applicant notes the requirements of MPEP §707.07, entitled "Completeness and Clarity of Examiner's Action". This MPEP section cites 37 CFR §1.104, entitled "Nature of examination", which, in turn, states, in subsection (b), entitled "Completeness of examiner's action" that "The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made."

This MPEP section further states, under a heading labeled "Examiner Note" that "The Examiner must, however, address any arguments presented by the applicant which are still relevant to any references being applied." The Office Action clearly fails to comport with these requirements as set forth in the MPEP, at least because the Office Action both fails to address Applicant's arguments with respect to anticipation and continues to reject claims as being anticipated.

More specifically, Applicant has provided separate legal arguments regarding at least five requirements for a valid finding of anticipation. These arguments have been ignored, and a rebuttal based on unpatentability has been substituted for any meaningful legal rebuttal of Applicant's arguments.

A second deficiency is that even under the unpatentability rejections, the combinations fail to provide all of the features recited in any of Applicant's independent claims. The Examiner has ignored these features without providing any appropriate legal basis for doing so.

A third deficiency is the failure to respond to all arguments traversing the unpatentability rejections. Merely repeating that "it would be obvious" to provide the features recited in the claims does not constitute a basis for rejection of the claims, particularly when the references fail to provide the features recited in the claims and the rejections fail to meet the standards for such rejections as set forth in the MPEP and as demonstrated by Applicant.

A fourth deficiency is to quote legal precedent with no regard for context, as is repeatedly done in the Office Action. For example, the surrebuttal of Applicant's response with respect to anticipation has been, and continues to be, based on legal precedent having no relationship whatsoever to anticipation, as demonstrated with specificity by Applicant's representative in the Response dated May 26, 2004 (see, e.g., page 25 et seq. of such Response).

For at least these reasons, the Office Action fails to comport with appropriate standards for examination. The Examiner should either allow Applicant's claims or provide a meaningful basis for rejection and an appropriate response to Applicant's arguments.

CONCLUSION

Claims 1-3, 5, 6 and 8-40 are allowable over the art of record. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

Date: Nov. 23, 2004



Frederick M. Fliegel
Reg. No. 36,138
(509) 324-9256 x239